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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal 2009-004411
Application 09/824,404
Technology Center 2100

Ex parte PETER KASSAN, ROBERT BARRITZ, STEVEN BARRITZ, and
GERALD COHEN

Decided: October 28, 2009

Before JAMES D. THOMAS, THU A. DANG, *and* STEPHEN C. SIU,
Administrative Patent Judges.

DANG, *Administrative Patent Judge.*

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal the Examiner's final rejection of claims 1-28 under 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b)(2002).

We AFFIRM.

A. INVENTION

According to Appellants, the invention relates to commerce and, more particularly, to a system for managing assets and relationships (Spec. 1, ll. 15-16).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. An asset tracking, managing and servicing system, comprising:

a user-referenced subsystem including, for each of a plurality of users, a respective asset and relationship tracking repository database operable to store data records relating to user-based assets or user-based information, and further including a records associator and a request processor;

a plurality of at least one of a service and product, vendor-referenced, databases comprising at least one of a service and product, vendor-referenced data records which constitute data records describing vendor-referenced services or products, the at least one of a service and product, vendor-referenced data records comprising at least one of service and product information; and

a control and communication subsystem that causes interactions between asset and relationship tracking repository data records that are user-referenced and the at least one of a service and product, vendor-referenced data records that are vendor-referenced, in a manner that creates current user information, including via interactions initiated by vendors, and

enables tracking the user-based assets and managing servicing
for the user-based assets for each of the plurality of users.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on
appeal is:

Harrington	US 5,895,454	Apr. 20, 1999 (filed on April 17, 1997)
Barlow	US 6,038,551	Mar. 14, 2000 (filed on Mar. 11, 1996)

Claims 1-9 stand rejected under 35 U.S.C. § 102(e) as anticipated by
the teachings of Harrington; and

Claims 10-28 stand rejected under 35 U.S.C. § 103(a) over the
teachings of Harrington in view of Barlow.

II. ISSUE

The issue is whether Appellants have shown that the Examiner erred
in determining that Harrington teaches “a control and communication
subsystem” that “causes interactions,” including “via interactions initiated
by vendors,” and “enables tracking the user-based assets and managing
servicing for the user-based assets” (claim 1).

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of
the evidence:

Harrington

1. Harrington discloses vendors providing user accessible databases which allow a local user to view information related to the products/services and purchase those products/services (col. 1, ll. 18-26).
2. Providers of products/services promote and sell a wide range of products and services by establishing a website (col. 1, ll. 28-33).
3. A local user interacts with the database by means of an interface wherein the interaction comprises the user querying the database to specify a local user's product/service specification (col. 2, ll. 29-32).
4. The selection of a particular product/service triggers a transaction notification which records the user's selection and associated financial transaction data which is transmitted to the database and associated database interface, wherein the local user may connect to subsequent remote vendor network sites (col. 2, ll. 42-50).
5. If a user wishes to obtain specific products/services from a particular region with a particular delivery time, these criteria would be input into the database interface (col. 5, ll. 25-29).

IV. PRINCIPLES OF LAW

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a

claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

“Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) “In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.” *Id.* (citations omitted).

The *claims* measure the invention. *See SRI Int’l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). “[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). “Moreover, limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

Of course, anticipation “is not an ‘ipsissimis verbis’ test.” *In re Bond*, 910 F.2d 831, 832-33 (Fed. Cir. 1990) (citing *Akzo N.V. v. United States Int’l Trade Comm’n*, 808 F.2d 1471, 1479 n.11 (Fed. Cir. 1986)). “An anticipatory reference . . . need not duplicate word for word what is in the claims.” *Standard Havens Prods., Inc., v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991).

When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art

in terms of patentability. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).
Cf. In re Gulack, 703 F.2d 1381, 1385 (Fed. Cir. 1983).

“An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.” *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003).

V. ANALYSIS

Claims 1-9

Regarding claim 1, Appellants argue that “Harrington regards and solves a completely different problem than recognized and solved” by Appellants (App. Br. 3). In particular, Appellants contend that Harrington does not disclose the “claimed ‘control and communication subsystem’ that enables ‘tracking’ of ‘user-based assets’ and ‘managing service for the user-based assets’” (*Id.*) because “Harrington teaches a user interacting with the database to ‘specify a local users product/service specification’” (App. Br. 3-4). That is, Appellants contend that “‘local [user’s] product specification’ is not a user-based asset” (App. Br. 4).

Appellants also contend that “Harrington provides no analog or even similar structure or functionality of ‘interactions initiated by vendors’” since Harrington “is entirely silent regarding a vendor being able to comb a particular database” (*Id.*)

The Examiner finds that Harrington's "tracking the user preference corresponds [sic] to the claimed invention" (Ans. 9), wherein "[a] hierarchical scheme could allow the selection of country, city or region based criteria depending on the [user's] specific requirements" (*Id.*). As to the claimed "interaction initiated by vendor," the Examiner finds that "the vendor is required to provide the information to the [sic] be stored in a database or website or to an end user, prior to the user interaction with the [sic] that specific vendor, because if the vendor will not initiate [sic] that interaction the end user will never know that vendor exists in the first place" (Ans. 10).

Accordingly, the issue that we address on appeal is whether Harrington teaches "a control and communication subsystem" that "causes interactions," including "via interactions initiated by vendors," and "enables tracking the user-based assets and managing servicing for the user-based assets" as specifically recited in claim 1.

We begin our analysis by giving the claims their broadest reasonable interpretation. *See In re Bigio*, 381 F.3d at 1324. Furthermore, our analysis will not read limitations into the claims from the specification. *See In re Van Geuns*, 988 F.2d at 1184.

Claim 1 simply does not place any limitation on what the term "assets" in "user-based assets" or "initiated" in "interaction initiated by vendors" means, includes, or represents, other than that the control and communication subsystem "causes interactions," including "via interactions

initiated by vendors,” and “enables tracking the user-based assets and managing servicing for the user-based assets.” In fact, “user-based” is merely a label used to describe the assets.

Therefore, we will not confine the meaning of “user-based assets” and “interactions initiated by vendors” to the definition provided in Appellants’ arguments. Rather, we interpret the “user-based assets” as anything, tangible or intangible, relating to a user. Further, we interpret “interactions initiated by vendors” as any interactions wherein the vendor has taken the first step.

Appellants’ arguments that “Harrington regards and solves a completely different problem than recognized and solved” by Appellants (App. Br. 3), and that “Harrington provides no analog or even similar structure or functionality of ‘interactions initiated by vendors’” since Harrington “is entirely silent regarding a vendor being able to comb a particular database” (App. Br. 4) are not commensurate in scope with the language of claim 1. That is, claim 1 does not recite any such “problem” that is “recognized and solved” or any such “analog or even similar structure or functionality” that enables the vendor “to comb” the database, as Appellants contend.

Furthermore, we note that the claimed features of “causes interactions,” including “via interactions initiated by vendors,” and “enables tracking the user-based assets and managing servicing for the user-based assets” (claim 1, emphasis added) appear to represent a mere intended use of

the “control and communication subsystem.” That is, the “interactions” and “tracking” are not positively recited as being performed. Claim 1 thus merely sets forth a subsystem which is not even required to perform the intended use functions.

Harrington discloses a user querying the database to specify a local user’s product/service specification (FF 3), wherein the user’s selection of a particular product/service and associated financial transaction data are recorded and transmitted to the database so that the user may connect to subsequent remote vendor network sites (FF 4) and the user’s criteria would be input into the database interface (FF 5). The skilled artisan would have understood the storing of the user’s criteria and selection for specific products/services based on the criteria to be “tracking” of things relating to a user and “managing” the servicing. That is, we agree with the Examiner that Harrington’s system for “tracking the user preference corresponds” to the claimed subsystem that “enables tracking the user-based assets” (Ans. 9), wherein “[a] hierarchical scheme could allow the selection of country, city or region based criteria depending on the users specific requirements” (*Id.*). Thus, we find the skilled artisan would have understood Harrington to teach the claimed features of “enables tracking the user-based assets and managing servicing for the user-based assets” as required by claim 1.

Furthermore, Harrington discloses vendors providing user accessible databases (FF 1), wherein providers of products/services promote and sell a wide range of products and services by establishing a website (FF 2). The

skilled artisan would have understood interactions in response to the vendor's providing of user accessible databases and promoting the products/services to be interactions wherein the vendor has taken the first step. That is, we agree with the Examiner that Harrington's interaction in which "the vendor is required to provide the information" to be stored in a database or website "prior to the user interaction" is a vendor "initiated" interaction, because the vendor HAS to initiate the interaction for the end user to know that vendor "exists in the first place" (Ans. 10). Thus, we find the skilled artisan would have understood Harrington to teach the claimed features of "a control and communication subsystem" that "causes interactions" including "via interactions initiated by vendors," as required by claim 1.

Accordingly, we find that the Appellants have not shown that the Examiner erred in finding independent claim 1 anticipated by Harrington. Thus, we find that the Appellants also have not shown that the Examiner erred in rejecting independent claim 1 and claims 2-10 depending therefrom and falling therewith under 35 U.S.C. § 102(e).

Claims 10-28

As to claims 10-28, Appellants do not provide separate arguments from the rejection of claim 1, from which they depend. Appellants contend that Barlow also "does not teach or suggest applicants' claim 1 control and communication subsystem" (App. Br. 5). As discussed above with respect

to claim 1 from which claims 10-28 depend, we agree with the Examiner that Harrington discloses such claimed features. We conclude that the Appellants have not shown that the Examiner erred in rejecting dependent claims 10-28 over the teachings of Harrington in view of Barlow under 35 U.S.C. § 103(a).

VI. CONCLUSIONS

(1) Appellants have not shown that the Examiner erred in finding that claims 1-9 are anticipated by the teachings of Harrington.

(2) Appellants have not shown that the Examiner erred in concluding that claims 10-28 are unpatentable over the teachings of Harrington in view of Barlow.

(3) Claims 1-28 are not patentable over the prior art of record.

VII. DECISION

The Examiner's decision rejecting claims 1-9 under 35 U.S.C. § 102(e) and rejecting claims 10-28 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Appeal 2009-004411
Application 09/824,404

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